

1 REMARKS

2 The Applicants respectfully request reconsideration and allowance of claims 1-18 and  
3 20-23, and consideration and allowance of new claim 24 in view of the above amendments and  
4 the following arguments.

5  
6 I. THE AMENDMENTS

7 Each of the independent claims, claims 1, 9, and 18, is amended above to clarify that the  
8 game play result in fact specifies the prize value. This amendment is supported in the original  
9 disclosure at the paragraph beginning at line 3 on page 16, and more specifically at lines 6-13 of  
10 page 16. Claim 23 is amended to correct a typographical error in the previous amendment.  
11 Claim 24 is added to further require the table look up step disclosed at page 16, lines 6-10.  
12 Because these amendments are fully supported by the original disclosure, they do not introduce  
13 new matter.

14  
15 II. THE CLAIMS AS AMENDED ARE NOT ANTICIPATED BY THE CITED ART

16 The Office Action rejected claims 1-7, 18, and 20-22 under 35 U.S.C. §102(e) as being  
17 anticipated by U.S. Patent Application Publication No. 2003/003980 to Moody ("Moody" or the  
18 "Moody reference"). The Applicants respectfully submit that the claims as amended are not  
19 anticipated by Moody.

20 The Moody reference discloses a gaming system in which a player may achieve an  
21 occurrence which earns the player the opportunity to play a secondary event bonus round game  
22 (Moody at paragraph 0017). When the player wins a chance to play the secondary event game,

1 the gaming machine randomly selects the amount of award to be won by the player during the  
2 secondary event game (Moody at paragraph 0019). Thus the amount to be awarded to the player  
3 for the secondary event game is not specified by the game play result obtained for the game play  
4 request in the primary game.

5 The Moody arrangement for identifying a prize to be awarded in a secondary game is  
6 fundamentally different from the Applicants' arrangement set out in claim 1 as amended. Claim  
7 1 requires that the prize value is specified by the game play result which was obtained in  
8 response to the player's game play request. In the Applicants' claimed system this prize value,  
9 the prize value specified by the game play result, is the prize value that is ultimately displayed to  
10 the player as a result for the bonus round selection as set out at element (e) of claim 1.

11 Because the Moody reference does not disclose that the prize value displayed to the  
12 player as the result for the bonus round selection is a prize value specified by the game play  
13 result obtained for the original game play request, the Moody reference does not anticipate claim  
14 1 and claims depending from claim 1.

15 The same comments apply to the other independent claims in the case, claims 9 and 18.  
16 Therefore Moody also does not anticipate claims 9 and 18 and their respective dependent claims.

17 It is noted that the randomly selected secondary event game award described at paragraph  
18 0019 of Moody cannot be considered the "game play result" required in the present claims  
19 because the randomly selected secondary event game award is not obtained in response to a  
20 game play request. Rather, the secondary event game award is obtained in response to an  
21 occurrence achieved by the player in the primary game. Thus it is not possible to side step the

1 deficiency of the Moody reference as to the present claims by defining the secondary event game  
2 award in Moody as the Applicants' claimed "game play result."

3 The Applicants note the comment in the Office Action at page 4, lines 7-10, regarding the  
4 interpretation of the reference to a "bingo-type game" in claim 3. The Applicants respectfully  
5 submit that there is absolutely no basis in the record for the conclusion that the "bingo-type  
6 game" referenced in claim 3 is somehow not a bingo game. However, the point is moot in that  
7 Moody at least suggests that the primary game may be a bingo game (Moody at paragraph 0016).  
8 However, this teaching of Moody regarding a bingo game as the primary game does not make up  
9 for the failure of Moody to disclose that the game play result specifies the prize value that is  
10 ultimately displayed to the player as a result for the bonus round selection as discussed above.

11  
12 III. THE CLAIMS AS AMENDED ARE NOT OBVIOUS IN VIEW OF THE CITED ART

13 The Office Action rejected claims 8 and 23 under U.S.C. §103(a) as being unpatentable  
14 over Moody in view of purported admitted prior art, rejected claims 9-15 and 17 under U.S.C.  
15 §103(a) as being unpatentable over Moody in view of official notice, and rejected claim 16 under  
16 U.S.C. §103(a) as being unpatentable over Moody in view of the official notice and further in  
17 view of purportedly admitted prior art. The Applicants respectfully submit that the claims as  
18 amended are not obvious on the ground that the cited prior art and proposed modifications to the  
19 cited prior art do not make up for the deficiency of the Moody reference as to the independent  
20 claims as discussed above in section II.

21 First off, the Applicants have made no admissions of prior art as suggested at page 6 of  
22 the Office Action. It remains a fundamental requirement for each and every obviousness

1 rejection that the Office must cite some combination of prior art references or modification of  
2 prior art references that includes each and every element set out in the claim in question. Failure  
3 to show each and every element of the claim renders the rejection fatally defective.

4 As to claims 8 and 23, the Office Action fails to make out a prima facie case of  
5 obviousness because it relies on mere assertions as to the content of the prior art without any  
6 showing of any reason in the prior art for making the proposed modification of Moody as to the  
7 requirements of claims 8 and 23.

8 Furthermore, even if one takes the rejection of claims 8 and 23 at face value, the  
9 proposed modification of Moody would not make up for the deficiency of Moody as to the  
10 independent claims. That is, the proposed modification of Moody would still not include a game  
11 play result that is obtained in response to a game play request and that specifies the prize value  
12 which is ultimately shown to the player as the result for the player's selection made in the bonus  
13 round.

14 The same arguments apply as to the rejection of claim 16 in view of purported admitted  
15 prior art.

16 For all of these reasons the Applicants believe that claims 8, 16, and 23 are not obvious  
17 in view of the cited art and are entitled to allowance.

18 In making the rejection of claims 9-15 and 17, the Office Action takes official notice of  
19 the game server element required in claim 9. However, this taking of official notice does not  
20 make up for the deficiency of Moody as to the independent claims. The proposed modification  
21 of Moody to include a result server does not result in a system in which a game play result  
22 obtained in response to a game play request specifies the prize value which is ultimately shown

1 to the player as the result for the player's selection in the bonus round (elements (a) and (c) of  
2 claim 1, elements (b) and (c) of claim 9, and element (b) of claim 15).

3 For all of these reasons the Applicants submit that claims 8-17 and 23 are not obvious in  
4 view of the cited prior art and are entitled to allowance, as is new claim 24.

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6 IV. CONCLUSION

7 For all of the above reasons the Applicants respectfully request reconsideration and  
8 allowance of claims 1-18 and 20-23, and consideration and allowance of new claim 24.

9 If any issue remains as to the allowability of these claims, or if a conference might  
10 expedite allowance of the claims, the Examiner is asked to telephone the undersigned attorney  
11 prior to issuing a further action in this case.

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13 Respectfully submitted,

14 The Culbertson Group, P.C.

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